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Filed: September 24, 2003
Confirmation No.: 4643

BRIEF FOR APPELLANT

Sir:

This is a Brief on appellant's Appeal from the Examiner's Final Rejection concerning the above-identified application.

The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all required fees under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18.; 37 C.F.R. §1.136.

BRIEF FOR APPELLANT

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I. REAL PARTY IN INTEREST

Unilever Home & Personal Care USA, Division of Conopco, Inc. is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no other prior or pending appeals or interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

Claims 1-17 are on Appeal. Original claims 1, 2, 7 and 10 were amended during prosecution. Claims 3-6 and 8-9 are original unamended claims. Claims 11-17 were submitted as new claims during prosecution.

IV. STATUS OF AMENDMENTS

Subsequent to the Final Office Action, there were no claim amendments.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed to a method for removing hair. The method includes applying to an area of skin from which hair is to be removed, a skin pre-treatment composition that comprises from 90 to 100% of lipophilic materials by weight of the pre-treatment

composition. In a subsequent step, a depilatory composition is applied onto the pre-treated area of skin, the depilatory composition comprising a keratin degrading agent in an effective amount to chemically react with hair to allow removal. See the specification at page 3, paragraph [0009] and page 6, paragraph [00019].

Dependent claim 2 specifies lipophilic materials as selected from the group consisting of hydrocarbons, natural or synthetic esters, silicones and mixtures thereof. See page 4, paragraph [00013].

Dependent claim 3 identifies the lipophilic material as being mineral oil. See page 12, paragraph [00039].

Dependent claim 4 identifies the keratin degrading agent as being a thioglycolate salt. See pages 6-7, paragraph [00020].

Dependent claim 5 identifies the skin pre-treatment composition as being applied for at least about one minute prior to application of the depilatory composition. See the original claim at page 19.

Dependent claim 6 requires the skin pre-treatment composition to be applied for at least five minutes prior to applying the depilatory composition. See the original claim at page 19.

Independent claim 7 is directed toward a kit for removal of hair from an area of skin. The kit includes a skin pre-treatment product and a depilatory product, along with instructions for use. The skin pre-treatment product is formed with 90-100% of lipophilic materials by weight of a pre-treatment composition, and a carrier for delivering the

composition onto the area of skin. The depilatory product includes a depilatory composition having a keratin degrading agent in an effective amount to chemically react with hair to allow wipe away removal, and a carrier for delivering the depilatory composition onto the area of skin subsequent to delivery of the pre-treatment composition. Instructions direct a user to apply the skin pre-treatment product to an area of skin requiring removal of hair followed by an application of the depilatory product over the same area. See pages 3-4, paragraph [00010] and page 6, paragraph [00019].

Kit claim 8 dependent through claim 7 identifies the carrier for delivering the skin pre-treatment composition as being a textile. See pages 9-10, paragraph [00029].

Kit claim 9 dependent through claim 8 identifies the textile as a glove. See page 10, line 3.

Method claim 10 depends through claim 1 and specifies that the depilatory and skin pre-treatment compositions are applied from respective carriers in weight ratios ranging from about 100:1 to about 1:100. See page 11, paragraph [00034].

Method claim 11 dependent through claim 1 identifies the lipophilic materials as present in an amount from about 98% to 100% by weight of the pre-treatment composition. See page 6, paragraph [00019].

Kit claim 12 dependent through claim 7 identifies the lipophilic materials as present in an amount from about 98% to 100% by weight of the pre-treatment composition. See page 6, paragraph [00019].

Kit claim 13 dependent through claim 7 identifies the lipophilic materials as selected from the group consisting of hydrocarbons, natural or synthetic esters, silicones and mixtures thereof. See page 4, paragraph [00013].

Kit claim 14 is dependent through claim 7 and identifies the lipophilic material as mineral oil. See page 12, paragraph [00039].

Kit claim 15 dependent through claim 7 identifies the keratin degrading agent as a thioglycolate salt. See page 6, paragraph [00020].

Method claim 16 dependent from claim 1 identifies the skin pre-treatment composition as consisting essentially of from 90 to 100% of lipophilic materials by weight of the pre-treatment composition, the lipophilic materials protecting skin from redness/erythema.

Kit claim 17 dependent through claim 7 similarly identifies the lipophilic materials. See page 6, paragraph [00019] and page 4, paragraph [00012].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Are claims 1-6, 10-11 and 16 obvious under 35 U.S.C. § 103(a) over LaHann et al. (U.S. Patent 4,546,112) in view of Michaels et al. (U.S. Patent 3,843,780)?

Are claims 7, 12-15 and 17 obvious under 35 U.S.C. § 103(a) over LaHann et al. in view of Michaels et al. and Orlow et al. (U.S. Patent 6,749,840 B2)?

Are claims 8 and 9 obvious under 35 U.S.C. § 103(a) over LaHann et al., Michaels et al. and Orlow et al. and further in view of Syed et al. (U.S. Patent 5,756,077)?

VII. APPELLANT'S ARGUMENTS

Are claims 1-6, 10-11 and 16 obvious under 35 U.S.C. § 103(a) over LaHann et al. (U.S. Patent 4,546,112) in view of Michaels et al. (U.S. Patent 3,843,780)?

Claims 1-6 and 10-11

Fundamental to LaHann et al. is the use of capsaicin as an active for preventing or reducing depilatory caused dermal irritation. Capsaicin is used at relatively low levels. These small amounts indicate that the material is an active substance chemically interacting with receptors in the skin. Carriers for this active substance are reported to be lotions, creams, solutions and gels. All of these forms include very large amounts of water. None of the different forms has more than about 50% of emollients some of which are lipophilic materials.

In contrast to a chemically active substance, the present invention provides a skin pretreatment composition operating in a physical manner. Lipophilic materials are believed to coat the skin thereby serving as a blanket protection against the subsequent application of caustic depilatory. The depilatory "sees" the keratin fibers but is shielded by the lipophilic materials from contact with underlying skin.

Thus, the present invention differs in concept and composition from that of the primary reference. LaHann et al. attenuates irritation through the chemical means of capsaicin. By contrast, appellant utilizes a physical blanket of lipophilic materials to separate the harsh depilatory from the skin but not from the keratin fiber. Appellant employs from 90 to 100% of lipophilic materials in the pretreatment composition. LaHann et al. does not appreciate the physical approach nor suggests using extremely high levels of lipophilic materials. For these reasons, LaHann et al. does not render the claims *prima facie* obvious.

In the Final Office Action, the Examiner highlights Example 3. Therein varying amounts from 1% to 8% capsaicin are applied to skin in some instances before and in some after depilation. The applied formula dissolves capsaicin in an isotonic saline solution containing 48% ethyl alcohol and 4% Tween 80 (surfactant emulsifier). Appellant notes that at least 90% if not more of the applied formula is other than lipophilic material. This contrasts sharply with the present claims. The active ingredient of capsaicin is utilized at a top level of only 8%. This contrasts with the extremely large amounts of lipophilic material utilized for purposes of the presently claimed invention.

Capsaicin as utilized by LaHann et al. is a dermatologically active chemical. By contrast, appellant's lipophilic material such as mineral oil is not dermatologically active. Appellant utilizes the lipophilic material composition for its coating properties. For this reason, it is inappropriate to compare capsaicin or its quantities with those of the claimed lipophilic material composition.

Michaels et al. was introduced for teaching mineral oil as a pretreatment composition in shaving. There is a significant difference between shaving and depilatory treatment. The former utilizes a sharp blade while the latter is chemical. Methods and

compositions which are useful against sharpened blades would not be obvious substitutes for the quite different depilatory treatment. Those skilled in the art would not be likely to employ the teachings focused on razor technology into the depilatory arts.

Yet even if the LaHann et al. and Michaels et al. references were combinable, the combination would still not provide a prima facie case of obviousness. The compositions of Michaels et al. utilize mineral oil at levels of maximum 85% by weight. See column 1, line 15. The remainder of the formula is anhydrous lower aliphatic monohydric alcohols. Aliphatic alcohol is defined as having from one to four carbon atoms, such as methanol, ethanol, propanol and butanol. See column 2, lines 39-42. These alcohols are not lipophilic materials.

Essentially the Examiner argues that the actually reported 75-85% disclosed mineral oil range is not so different from appellant's claimed 90-100%. Appellant disagrees. There actually is a difference both in kind and quantity. With respect to the latter, Michaels teaches away from anything in excess of 85%. The reference requires from 15 to 25% of anhydrous lower aliphatic monohydric alcohol. See column 1 (lines 16-17) and column 2 (lines 36-45). The anhydrous alcohol is present "to assist in the deposition of the mineral oil as a film on the skin". Those skilled in the art reading this reference would find a minimum of 15% anhydrous alcohol to be essential. This teaches away from the at least 90% of the present claims. Note also that lower aliphatic monohydric alcohols are hydrophilic rather than lipophilic; the alcohol changes the character of the mineral oil containing composition. Again this leads away from the present invention which seeks to apply a protective lipophilic coat to skin prior to depilation.

There also is a difference in kind. The mineral oil containing composition of Michaels is intended to lubricate the skin, the hair and the razor to increase comfort level during shaving. See column 1 (lines 65-67). By contrast, appellant utilizes the lipophilic material composition as a protective coating against the harsh chemicals of depilatories. There is no functional necessity in depilation to lubricate the skin or lubricate the hair or lubricate the nonexistent razor. Thus, the 90% lipophilic material composition has a function much different than that described by Michaels.

Cited in support of the Examiner's position was In re Aller, 105 USPQ233 (CCPA 1955). The case was selected for stating that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." The Examiner applied this to the present claims reciting 90-100% lipophilic materials. Yet unlike the present rejection of LaHann et al. in view of Michaels, In re Aller was a rejection over a single reference showing all elements except the claimed concentration range. The skilled chemist for In re Aller needed only to slightly adjust process temperature and reactant concentration. Yet with the present claims, the skilled chemist must not only increase lipophyl concentration but must transplant this adjusted value into a depilatory system found in a different reference. Especially in a situation where combination of such references is questionable, altering the concentration of one element is not obviously straightforward experimentation.

Claim 16

The Board is requested to independently consider claim 16 (and its kit equivalent claim 17). Claim 16 identifies the skin pre-treatment composition as one which "consists essentially of" the 90-100% lipophilic material. The transitional phrase of "consists essentially of" is construed by the Examiner as equivalent to "comprising". The

Examiner supports this view “because there is no disclosure in the specification or claims that using 90-100% is the basic novel characteristic of the present invention.”

Appellant draws attention to the comparative experiments under Example 1 and 2. Pretreatment was conducted with 100% mineral oil in both of those clinical trials. See paragraph [00040] and [00045], respectively.

Another questionable rejection was the Examiner’s view that the claim 16 phrase of “the lipophilic materials protecting skin from redness/erythema” was an inherent result. The Examiner further stated that “the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” This was cited from Ex parte Obiaya, 227 USPQ 58 (Bd. Pat. App. & Inter. 1985).

Appellant observes that Ex parte Obiaya first requires the establishment of a *prima facie* case of obviousness predicate to the dicta. The present Examiner has not yet established a *prima facie* case of obviousness. Neither of the references teach a pre-treatment with the extremely high levels of lipophilic materials as presently claimed.

A combination of LaHann et al. in view of Michaels et al. would not render the present invention obvious. Neither of the references discloses upwards of 90% lipophilic materials. Further, there simply is no suggestion or incentive for incorporating mineral oil at even 85% as disclosed by Michaels et al. into the primary reference. Irritation caused by razor attack is much different than the effect of chemical burn.

Are claims 7, 12-15 and 17 obvious under 35 U.S.C. § 103(a) over LaHann et al. in view of Michaels et al. and Orlow et al. (U.S. Patent 6,749,840 B2)?

Independent claim 7 recites a kit for removal of hair from an area of skin. The kit includes a skin pre-treatment product which comprises a pre-treatment composition comprising 90-100% lipophilic materials. Additionally present is a depilatory product comprising a composition with an effective amount of a keratin degrading agent effective to chemically react with hair and allow wipe away removal. Instructions are included in the kit on how to apply the pre-treatment product and then the depilatory product over a selected area of skin.

LaHann does not disclose a kit. Neither is there any disclosure of a pre-treatment composition that comprises any substantial amount of lipophilic materials. Indeed, the comparative examples at best hint at 50% maximum “emollient” with the balance being water. Any arguably pre-treatment compositions among the four Examples have greater than 90% hydrophilic rather than lipophilic material (i.e. water). LaHann uses a small amount of capsaicin as an active agent to control dermal irritation. This is a much different method and pre-treatment composition from the coating and highly lipophilic pre-treater of the present claims.

Michaels has nothing to do with depilatories. This is a disclosure concerned with attenuating the trauma of a shaving blade. Depilatory chemicals penetrate the hair follicle and react with the keratin. These are very harsh conditions. By contrast, shaving is a mechanical irritation and much more of a surface phenomena. Chemical irritation in the aftermath of depilation is different than irritation generated through a steel blade.

Michaels utilizes a mineral oil composition to lubricate the cutting blade, the hair target and the skin. There is no suggestion that the concept of lubrication would be appropriate for depilation. Indeed, the skilled chemist would conceptually avoid lipophilic materials as pre-treaters. The reason would be concern that a lipophilic coating over the hair would prevent the depilatory chemical from efficiently reacting therewith. Yet appellant was quite surprised that lipophilic materials such as mineral oil did not significantly inhibit the depilatory chemical reaction. But there was an improvement in lowering skin irritation. These were unexpected results.

Orlow was introduced as disclosing that personal care compositions are packaged with printed instructions as a label or package insert directing use of the composition.

Deficiencies of the primary references are not remedied by Orlow. Not only do the claims require instructions for the kit but the instructions must direct a user to apply the skin pre-treatment product prior to application of the depilatory. These instructions are not provided by Orlow. Neither does this reference disclose use of relatively high levels of lipophilic material as a skin pre-treatment composition. For these reasons, the claims are not *prima facie* obvious over the combination of art.

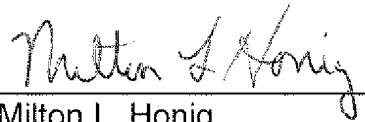
Are claims 8 and 9 obvious under 35 U.S.C. § 103(a) over LaHann et al., Michaels et al. and Orlow et al. and further in view of Syed et al. (U.S. Patent 5,756,077)?

Syed et al. does not remedy the basic deficiencies of the combination of the other references. There is no disclosure of utilizing a pre-treatment the composition comprising at least 90% of lipophilic materials. The reference is directed at hair coloring

rather than to depilation. The combination of art would not render the claims *prima facie* obvious.

In view of the foregoing comments, appellant requests the Board of Appeals and Interferences to reverse the rejections and now allow the claims.

Respectfully submitted,

A handwritten signature in cursive script, reading "Milton L. Honig", is written over a horizontal line.

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201-894-2403

VIII. CLAIMS APPENDIX

Claim 1. A method for removing hair comprising:

- (i) applying to an area of skin from which hair is to be removed a skin pretreatment composition that comprises from 90 to 100% of lipophilic materials by weight of the pretreatment composition; and
- (ii) applying onto the pretreated area of skin a depilatory composition comprising a keratin degrading agent in an effective amount to chemically react with hair to allow removal.

Claim 2. The method according to claim 1 wherein the lipophilic materials are selected from the group consisting of hydrocarbons, natural or synthetic esters, silicones and mixtures thereof.

Claim 3. The method according to claim 1 wherein the lipophilic material is mineral oil.

Claim 4. The method according to claim 1 wherein the keratin degrading agent is a thioglycolate salt.

Claim 5. The method according to claim 1 wherein the skin pretreatment composition is applied for at least about one minute prior to application of the depilatory composition.

Claim 6. The method according to claim 1 wherein the skin pretreatment composition is applied for at least five minutes prior to applying the depilatory composition.

Claim 7. A kit for removal of hair from an area of skin comprising:

- (a) a skin pretreatment product comprising:
 - (i) a skin pretreatment composition that comprises from 90 to 100% of lipophilic materials by weight of the pretreatment composition; and
 - (ii) a carrier for delivering the skin pretreatment composition onto the area of skin;
- (b) a depilatory product comprising:
 - (i) a depilatory composition comprising a keratin degrading agent in an effective amount to chemically react with hair to allow wipe away removal; and
 - (ii) a carrier for delivering the depilatory composition onto the area of skin subsequent to delivery of the pretreatment composition;
- (c) instructions to apply the skin pretreatment product to an area of skin requiring removal of hair followed by an application of the depilatory product over the area of skin covered by the pretreatment product.

Claim 8. The kit according to claim 7 wherein the carrier for delivering the skin pretreatment composition is a textile.

Claim 9. The kit according to claim 8 wherein the textile is a glove.

Claim 10. The method according to claim 1 wherein the depilatory and skin pretreatment compositions are applied from respective carriers in weight ratios ranging from about 100:1 to about 1:100.

Claim 11. The method according to claim 1 wherein the lipophilic materials are present in an amount from about 98% to 100% by weight of the pretreatment composition.

Claim 12. The kit according to claim 7 wherein the lipophilic materials are present in an amount from about 98% to 100% by weight of the pretreatment composition.

Claim 13. The kit according to claim 7 wherein the lipophilic materials are selected from the group consisting of hydrocarbons, natural or synthetic esters, silicones and mixtures thereof.

Claim 14. The kit according to claim 7 wherein the lipophilic material is mineral oil.

Claim 15. The kit according to claim 7 wherein the keratin degrading agent is a thioglycolate salt.

Claim 16. The method according to claim 1 wherein the skin pretreatment composition consists essentially of from 90 to 100% of lipophilic materials by weight of the pretreatment composition, the lipophilic materials protecting skin from redness/erythema.

Claim 17. The kit according to claim 7 wherein the lipophilic materials consists essentially of from 90 to 100% of lipophilic materials by weight of the pretreatment composition, the lipophilic materials protecting skin from redness/erythema.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.